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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/847,625 | 05/02/2001 | Luis A. Rovira | A-6671 | 5607 |

5642 7590 08/08/2006

SCIENTIFIC-ATLANTA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

LONSBERRY, HUNTER B

| | |
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| ART UNIT | PAPER NUMBER |
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2623

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,625

Applicant(s)

ROVIRA, LUIS A.

Examiner

Hunter B. Lonsberry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/22/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 27-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 27-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

I. Applicant's Claim amendments, dated 5/22/05, have been entered and made of record.

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant traverses the alleged finding of well known subject matter with regards to thestranger.com reference. Applicants submit that merely providing a reference (or couple of references) that allegedly discloses the subject matter in question, does not rise to an evidentiary level of being well known in the industry. Applicants submit that even if the cited references disclose the subject matter in question (a point that the Applicants are not conceding), presence of the subject matter in a reference does not raise the level of commonality of that subject matter to something of unquestionable fact. For this specific and particular reason, applicants submit that the subject matter in question is not well known in the art. (Pages 12-13).

Regarding Applicants assertions, the Examiner disagrees. The Examiner has provided a reference as required by the MPEP.

Applicant traverses the inherency taken in the previous office action (pages 13-14.

Regarding applicants argument, the Applicant has not provide any teaching nor argument why the inherency statement would not be true. Nonetheless, the Examiner questions how a user would be able to view a program prior to its scheduled time unless the user themselves has requested to view it at an earlier time.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

II. Claims 1, 3, 4, 7, 8, 10-12, 18-21, 25, 28, 29, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis*. (WO 99/60790) in view of U.S. Patent 6,211,901 to Imajima.

Claim 1 recites a method for providing media services comprising limitations, which are too numerous to recite herein, however each will be addressed in turn. As discussed in a previous action, dated 4/15/2005, *Ellis* discloses a system, which provides a user with an IPG (Pg. 1, Ln. 4-7) identifying a future program (Pg. 13, Ln 7-10). A user is allowed to request said future program prior to its later scheduled

broadcast time (i.e., user defined time prior to later start time). (Pg. 3, Ln. 7-10; Pg. 26, Ln. 4-7).

But, *Ellis* fails to teach whether the requested program is “otherwise available only via a scheduled broadcast to a plurality of users at a predetermined later time”, and providing said user with an option to view the scheduled future television program at a user-defined time. However, it is well known in this art for newly released programs to be available on VOD, pay-per-view, or any other similar system before they are available on non-pay television. This enables movie companies and content providers to receive additional profit. For Example, *Ellis* Figure 8, discloses the *Truman Show* being offered immediately in November of 1999 (PCT Publication date). A user is allowed to set a time for when he or she would like to view The Truman Show, but, it is not clear whether *The Truman Show* is “otherwise available only” via a later broadcast. However, the cited NPL reference (i.e., thestranger.com reference) shows the Truman Show being publicly available on NBC in February of 2001. These references, taken in combination, teach an IPG displaying a future television program (i.e., Truman Show), said future television program scheduled to be broadcast at a later time (i.e., on NBC in 2001), whereby the user is allowed to receive the program in advance of the later schedule time.

Furthermore, when taken in combination, it is inherent that the user would not otherwise receive the program in advance of its 2001 NBC date, unless he or she requested it in advance. Therefore, the *Truman Show* would be “available otherwise only” as a later scheduled broadcast on NBC. Accordingly, it would have been obvious

to one having ordinary skill in this art at the time of Applicant's invention to modify the teachings of *Ellis* with what was well known (as evidenced by "thestranger.com" reference) to provide a system which allows a user to request programs in advance of their exclusive future broadcast date, thereby providing an additional method of television revenue.

Ellis in combination with thestranger.com fails to disclose providing said user with an option to view the scheduled future television program at a user-defined time.

Imajima discloses that a user may select a program which is to be broadcast at a regularly scheduled future time via an NVOD service (figure 5, column 1, lines 35-40), a user may also request to view the program at a viewer defined time via the FVOD service (figure 7, column 1, lines 35-45) as the program is streamed to the user immediately and the user does not have to wait for the next NVOD broadcast to be able to watch the program, thereby providing a convenient and flexible way for a user to enjoy programming.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify *Ellis* in combination with thestranger.com to include the combination NVOD/FVOD features of Imajima for the advantages of allowing the program to be streamed to the user immediately and the user does not have to wait for the next NVOD broadcast to be able to watch the program, thereby providing a convenient and flexible way for a user to enjoy programming.

Claim 36 corresponds to Claim 19. Thus, it is analyzed and rejected as previously discussed with regards to claim 1.

As to claim 3, *Ellis* further discloses charging a user a fee in connection with the provision of programs. (Page 13, Ln. 18-20). Accordingly, the modified system of *Ellis* renders obvious all limitations of Claim 3.

Applicant's claim 4 recites a method of charging a user a fee in connection with providing access to future programs. As discussed under Claim 3, *Ellis* discloses a method of charging a user a fee in connection with the "provision" of a later scheduled program, but fails to teach a method of charging said user a fee in connection with providing "access" to said programs. However, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to modify the billing method of *Ellis* to also include charging the user for having "access" to the future television programming. Charging a fee for access to a program is an obvious variant of charging a fee for the provision of the program, thereby allowing the content provider an additional avenue of charging a user.

Claim 21 is an apparatus claim corresponding to the method claim 4, and is analyzed and rejected as previously discussed.

As to claim 7, *Ellis* further discloses an IPG which list information pertaining to program titles, times, channels, and descriptions. (page 3, Ln. 1-3). Accordingly, the modified system of *Ellis* renders obvious all limitations of Claim 7.

As to claim 8, *Ellis* further discloses an IPG, which utilizes a remote control device in order to display program information and to display the later schedule programs. (page 3, Ln 5-9). Accordingly, the modified system of *Ellis* renders obvious all limitations of Claim 8.

As to claim 10, *Ellis* further discloses an IPG in which television programs are received from a broadcasting network or i.e., content provider. (Page 1, Ln. 11-13). Accordingly, the modified system of *Ellis* renders obvious all limitations of Claim 10.

As to claim 11, *Ellis* discloses a method of storing a video on demand program within a home storage device (page 24, Ln. 4-9). Accordingly, the modified system of *Ellis* renders obvious all limitations of Claim 11.

Claim 28 is an apparatus claim corresponding to the method claim 11, and is analyzed and rejected as previously discussed.

As to claim 12, *Ellis* further discloses an IPG system, which stores programs in devices capable of being connected, i.e., coupled, to a set-top box, i.e. client device.

(Page 15, Ln. 28-32). Accordingly, the modified system of *Ellis* renders obvious all limitations of Claim 12.

As to claim 18, *Ellis* further discloses an IPG, which provides user with access to current television programs (page 13, Ln. 10). Accordingly, the modified system of *Ellis* renders obvious all limitations of Claim 18.

Claims 19, 20, 25, 29 and 35 are apparatus claims corresponding to the method claims 1, 3, 7, 12, and 18 respectively. Accordingly, claims 19, 20, 25, 29 and 35 are analyzed and rejected as previously discussed.

III. Claims 2 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in view of Imajima (US #6,211,901) in further view of *Kostreski* (US #5,534,912).

Applicant's claim 2 recites the method of Claim 1, further comprising confirming a user's authorization to receive a television program. As discuss above, the modified system of *Ellis* and Imajima renders obvious all limitations of Claim 1, but fails to teach the use of any method of authorization. Within the same field of endeavor, *Kostreski* teaches a means for indicating which channels are authorized to a user. (Col 8, Ln. 3-22). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the modified system of *Ellis and Imajima* with the authorization means of *Kostreski* in order to provide an efficient mechanism for verification.

Claim 22 is an apparatus claim corresponding to the method claim 2, and is analyzed and rejected as previously discussed.

IV. Claims 5, 6, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in view of *Imajima* (US #6,211,901) in further view of *Matthews, III* (US #5815145).

Applicant's claim 5 discloses an IPG which contains a table corresponding to individual episodes of a given future television program. As discussed above, the modified system of *Ellis* and *Imajima* renders obvious all limitations of Claim 1, but fails to disclose an IPG containing a episode database. However, within the same field of endeavor, *Matthews, III*, discloses an IPG database containing episodes corresponding to television programs. (Col. 7, Ln 48-49). Therefore, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the modified system of *Ellis and Imajima* with the episode database of *Matthews III* in order to provide a more detailed and extensive program list for the user to choose from.

Claim 23 is an apparatus claim corresponding to the method claim 5, and is analyzed and rejected as previously discussed.

As to claim 6, *Ellis* further discloses that the programs listed in the IPG could be sit-coms or dramas, but fails to specifically list whether programs could be soap-operas. (Page 18, Ln. 20-21). However, claim 6 recites a Markush Group, which are anticipated if it is shown that one alternative is contained within the prior art. Accordingly, the modified system of *Ellis* renders obvious all limitations of Claim 6. (Moreover, the

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examiner would like to note that soap operas are considered to be an obvious variant of a sit-com or drama, which were combined to provide a more exhaustive listing and would be rejected accordingly.)

Claim 24 is an apparatus claim corresponding to method claim 6, and is analyzed and rejected as previously discussed.

V. Claims 9, 15, 16, 17, 27, 32, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in view of *Imajima* (US #6,211,901) in further view of *Girard et al.* (US # 5,751,282).

Applicant's claim 9 recites the method of claim 1, wherein the future television program is received from a headend. As discussed above, the modified system of *Ellis* and *Imajima* renders obvious all limitations of Claim 1, but fails to specifically state that the program can be received from a headend. However, within the same field of endeavor, *Girard* teaches a video signal being received from a head end. (Col. 3, Ln 8-10). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the modified system of *Ellis* and *Imajima* with the headend teaching of *Girard* in order to provide a multi-tier distribution structure.

Claim 27 is an apparatus claim corresponding to method claim 9, and is analyzed and rejected as previously discussed.

Applicant's claim 15 recites the method of claim 1, wherein the future program is stored in a device located inside a cable television system. As discussed above, the modified system of *Ellis and Imajima* renders obvious all limitations of Claim 1, but fails to specifically disclose whether a storage device is located inside a cable television system. Within the same field of endeavor, *Girard* discloses a program storage device, which is contained within a cable television system. (Fig. 1). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the modified system of *Ellis and Imajima* with the storage device of *Girard* in order to provide an alternative method of storing said future programs.

Claim 32 is an apparatus claim corresponding to the method claim 15, and is analyzed and rejected as previously discussed.

Applicant's claim 16 recites a method of claim 1, wherein the future program is stored in a device coupled to a cable television system. As discussed above, the modified system of *Ellis and Imajima* renders obvious all limitations of Claim 1, but fails to specifically state whether a storage device is coupled to a television system. Within the same of field of endeavor, *Girard* discloses that the program storage device is contained within or, i.e., coupled to, a cable television system. (Fig. 1). Accordingly it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the modified system of *Ellis and Imajima* with the cable system

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storage teaching of *Girard* in order to provide an alternate method of storing said future programs.

Applicant's claim 17 recites the method of claim 1 wherein the user is provided with access to previously broadcasted television programs. As discuss above, the modified system of *Ellis and Imajima* renders obvious all limitations of Claim 1, but fails to specifically discuss providing access to previously broadcasted television programs. Within the same field of endeavor, *Girard* teaches the user's access to previously broadcasted television programs. (Col. 2, Ln. 19-21 & 30-32). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to further modify the system of *Ellis and Imajima* to provide access to previously broadcasted programs in order to provide the user with a wider selection of programs to choose from.

Claims 33 and 34 are apparatus claims corresponding to the method claims 16 and 17, respectively. Accordingly, they are analyzed and rejected as previously discussed.

VI. Claims 13, 14, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in view of *Imajima* (US #6,211,901) in further view of *Gordon et al.* (US #5,682,597).

Applicant's claims 13 and 14 recite methods of storing said television programs in either a hub or node, respectively. As discussed above, the modified system of *Ellis and Imajima* renders obvious all limitations of Claim 1, but fails to specifically state whether programs can be stored in hubs or nodes. Within the same field of endeavor, *Gordon* teaches the use of hubs and nodes, which are used to store video programs. (Col. 1, Ln. 65-68). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the modified system of *Ellis and Imajima* with the hub and node storage teaching of *Gordon* in order to provide alternate methods of storage.

Claims 30 and 31 are apparatus claims corresponding to method claims 13 and 14, respectively. Accordingly, they are analyzed and rejected as previously discussed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 571-272-7298. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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HBL

Hunter Lonsberry
Patent Examiner
Art Unit 2623